

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Anders (nmi) Vinberg
Serial No.: 10/091,067
Filing Date: March 4, 2002
Group Art Unit: 2452
Examiner: Philip C. Lee
Confirmation No.: 8007
Title: METHOD AND APPARATUS FOR GENERATING AND
 RECOGNIZING SPEECH AS A USER INTERFACE ELEMENT
 IN SYSTEM SAND NETWORK MANAGEMENT

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

CORRECTED APPEAL BRIEF

Appellant appealed to the Board of Patent Appeals and Interferences ("*Board*") from the Final Office Action dated December 31, 2008 and the Advisory Action dated April 13, 2009 by filing a Notice of Appeal and Pre-Appeal Brief on April 17, 2009 with the statutory fee of \$540.00. Appellant filed an Appeal Brief in response to Notice of Panel Decision from Pre-Appeal Brief Review dated July 30, 2009, finally rejecting Claims 1, 3-11, 13, 15, and 17-24 on August 26, 2009. Appellant hereby files this Corrected Appeal Brief in response to the Notification of Non-Compliant Appeal Brief dated November 23, 2009.

REAL PARTY IN INTEREST

This Application is currently owned by Computer Associates Think, Inc. as indicated by:

an assignment recorded on 11/25/2002 from inventor Anders Vinberg to Computer Associates Think, Inc., in the Assignment Records of the PTO at Reel 013520, Frame 0528 (4 pages).

RELATED APPEALS AND INTERFERENCES

Appellant identifies the following appeal that may be related to or that may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No.:	tbd
App. Ser. No.:	10/091,065
Priority Info:	Claims the benefit of 08/892,919
Appellant:	Anders Vinberg
Represented by:	Baker Botts LLP
Assignee:	Computer Associates Think, Inc. (pursuant to assignment recorded at reel 013520, Frame 0080)
Status:	Appeal Brief Submitted on August 25, 2009; awaiting decision of Board of Patent Appeals and Interferences

Appellant additionally identifies the following appeal that may be related to or that may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No.:	2009-011165
App. Ser. No.:	09/949,101
Priority Info:	Claims the benefit of 08/892,919
Appellant:	Reuven (nmi) Battat, et al.
Represented by:	Baker Botts LLP
Assignee:	Computer Associates Think, Inc. (pursuant to assignment recorded at reel 012161, Frame 0483)
Status:	Reply Brief submitted on December 30, 2008; awaiting decision of Board of Patent Appeals and Interferences

Copies of the Appeal Briefs filed in the identified cases are included in Appendix C. To the knowledge of Appellant's counsel, there are no other known appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision regarding this Appeal.

STATUS OF CLAIMS

Claims 1, 3-11, 13, 15 and 17-24 are pending and stand rejected pursuant to a Final Office Action dated December 31, 2008 ("*Final Office Action*") and a Notice of Panel Decision from Pre-Appeal Brief Review dated July 30, 2009 ("*Panel Decision*"). Specifically, the *Final Office Action* includes the following rejections:

1. Claim 3 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. However, in an Advisory Action dated April 13, 2009 ("*Advisory Action*"), the Examiner has withdrawn this rejection of Claim 3.
2. Claims 1, 4, 13, 15, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,367,670 issued to Ward et al. ("*Ward*") in view of U.S. Patent No. 6,603,396 issued to Lewis et al. ("*Lewis*"), in view of U.S. Patent No. 5,745,692 to Lohmann II et al. ("*Lohmann*").
3. Claims 9, 17, and 21-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of U.S. Patent No. 6,021,262 to Cote, et al. ("*Cote*").
4. Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of U.S. Patent No. 4,881,197 to Fischer ("*Fischer*").
5. Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of U.S. Patent No. 6,037,099 to Sabourin, et al. ("*Sabourin*").
6. Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of U.S. Patent No. 6,421,707 to Miller, et al. ("*Miller*").
7. Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of U.S. Patent No. 6,161,082 to Goldberg, et al. ("*Goldberg*").

8. Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann* and *Fischer* in view of “Official Notice”.
9. Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann* and *Cote* in view of U.S. Patent Publication No. 2001/0044840 filed by Carleton (“*Carleton*”).
10. Claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann* and *Cote* in view of U.S. Patent Publication No. 2004/0210469 filed by Jones et al. (“*Jones*”).
11. Claim 23 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ward, Lewis, and Lohmann*, and *Cote* in view of U.S. Patent No. 6,185,613 to Lawson, et al. (“*Lawson*”).

Claim 2 was previously cancelled in a Response to Office Action submitted by Appellant on January 13, 2006. Claims 12, 14, and 16 were previously cancelled in a Response to Office Action submitted by Appellant on November 16, 2006.

For the reasons discussed below, Appellant respectfully submits that the rejections of Claims 1, 3-11, 13, 15, and 17-24 are improper and should be reversed by the Board. Accordingly, Appellant presents Claims 1, 3-11, 13, 15, and 17-24 for Appeal. All pending claims are shown in Appendix A, attached hereto.

STATUS OF AMENDMENTS

In the Response to Final Office Action submitted by Appellant on March 30, 2009 (*“Response to Final”*), Appellant amended Claim 3 address a rejection of the claim under 35 U.S.C. § 112, second paragraph. In the Advisory Action delivered on April 13, 2009 (*“Advisory Action”*), the Examiner entered the amendments and withdrew the rejection of Claim 3 under § 112, second paragraph. (*Advisory Action*, pages 1-2). Claim 3 is shown in the amended form in Appendix A, attached hereto.

No other amendments were submitted after the *Final Office Action*. Accordingly, all amendments submitted by Appellant have been entered by the Examiner.

SUMMARY OF CLAIMED SUBJECT MATTER

An exemplary IT enterprise is illustrated in Figure 1A. The IT enterprise 150 includes local area networks 155, 160 and 165. IT enterprise further includes a variety of hardware and software components, such as workstations, printers, scanners, routers, operating systems, applications, and application platforms, for example. The components of IT enterprise 150 may be monitored and managed in accordance with the present disclosure. (Page 5, lines 16-21.)

The various components of an exemplary management system 100 topology that can manage an IT enterprise in accordance with the present disclosure are shown in Figure 1B. The management system 100 includes at least one visualization workstation 105, an object repository 110, one or more management applications 115, and one or more management agents 120 associated with each management application 115. (Page 4, lines 22-26.)

The visualization workstation 105 provides a user access to various applications including a network management application 115. Workstation 105 interacts with an object repository 110 which stores and delivers requests, commands and event notifications. Workstation 105 requests information from object repository 110, sends commands to the object repository, and gets notification of events, such as status changes or object additions from it. The object repository 110 receives request information from the management application 115, which is fed by the management agents 120 responsible for monitoring and managing certain components or systems in an IT enterprise. (Page 4, line 27 - page 5, line 4.)

The management application 115 maintains object repository 110 to keep track of the objects under consideration. The object repository 110 may be a persistent store to hold information about managed components or systems, such as a database. In an alternative embodiment, the management application 115 and object repository 110 may be integrated into a single unit that can hold information about managed components in volatile memory and perform the tasks of the management application. (Page 5, lines 5-10.)

As shown, one architectural aspect of the present system is that in normal operation, the visualization workstation 105 interacts primarily with the object repository 110. This reduces network traffic, improves the performance of graphical rendering at the workstation, and reduces the need for interconnectivity between the visualization workstation 105 and a multitude of management applications 115, their subsystems and agents 120 existing in IT

enterprises. Of course, embodiments having other configurations of the illustrated components are contemplated, including a stand-alone embodiment in which the components comprise an integrated workstation. (Page 5, lines 11-18.)

In addition to handling requests, commands and notifications, object repository 110 may also handle objects describing the structure and operation of the management system 100. Such objects may describe the momentary state, load, and performance of the components and/or systems. Such objects may be populated using a manual process or an automatic discovery utility. (Page 5, lines 19-23.)

According to one embodiment, the management system of the present disclosure includes an alert system that is capable of providing audio alerts to operators. Another embodiment of the management system of the present disclosure includes the alert system and a command/control system that is capable responding to verbal commands from devices that supports speech generation or reproduction. (Page 5, lines 24-28.)

The alert system includes an alert generation component that communicates with a speech generation component to provide speech-based audio alerts. The command/control system includes a speech recognition component that communicates with a command/control component (or user interface) to enable human operators to verbally request retrieval of information from the management system, or to verbally issue commands to the management system to take certain actions. This combined speech-based alert system and command/control system may be incorporated as part of the management application 115 of the management system 100 or as a user interface in any kind of component (e.g., computer) connected to the IT enterprise. In one embodiment, this is accomplished using speakers and a microphone, or in alternative configurations, using a headset with headphones and an integrated microphone. In alternative embodiments, the combined alert system and command/control system (collectively referred to herein as the ACC system) is connected to a telephony system, to allow alert messages to be sent out to an operator through a telephone and commands to be received through a telephone. In still other alternative embodiments, the speech-based system may be connected to a handheld device, such as a Palm Pilot. Of course, any handheld device used with the present system should be capable of supporting audio and/or speech generation. Thus, the present system is readily capable of exploiting any new devices supporting speech generation as they become available. (Page 5, line 29 - page 6, line 17.)

Referring now to Figure 2, one embodiment of an ACC system according to the present disclosure is shown. The alert system 107 includes alert generation component 205 and speech generation component 215 that interacts with devices 210-245, as described below, via router 220. The command/control system 108 includes command/control component 250 and speech recognition component 210 that interacts with devices 210-245, as described below, via router 220. Information can be stored in or retrieved from object repository 110 by alert generation component 205 or command control component 250. In this embodiment, at least a portion of the ACC system is integrated with the management application 115 and another portion of the ACC system is integrated with the object repository 110. In an alternative embodiment, the ACC system can be integrated with the management application 115, and in another alternative embodiment the ACC system can be integrated with the object repository 110 and another component in the IT enterprise. (Page 6, lines 18-30.)

In addition, in the embodiment of Figure 2, the alert system 107, the command/control system 108 or both interact with the devices 210-245 via a single communication path, e.g., router 220. This configuration provides a unified alerting system and a unified command-and-control system for various enterprise components, networks or subsystems in the IT enterprise. Further, like management application 115, other enterprise components, networks and/or subsystems may populate the object repository 110 with event notifications that may be delivered according to the methodology of the present application. (Page 7, lines 1-8.)

In conventional management systems subsystems are typically responsible for generating and delivering their own event notifications, and handling commands from operators (or users). For example, virus detection, intrusion detection, system performance monitoring, network monitoring, application monitoring, job scheduling, and access control are traditionally handled by separate subsystems with separate user interfaces and separate alerting systems. By providing an integrated user interface for reporting events and receiving commands in accordance with the present disclosure, management systems can more efficiently manage an enterprise, particularly with regard to the use of audio notifications and commands. (Page 7, lines 9-17.)

In addition to communicating event notifications to visualization workstation 105, object repository 110 further provides such notifications to the alert generation component 205. Alert generation component 205 processes each notification to determine whether an audio alert notification should be transmitted, and if so, determines how the alert is to be transmitted.

If the alert generation component 205 is configured to provide an audio alert notification for a particular event, alert generation component 205 employs speech generation component 215 to generate the audio alert notification. The audio alert notification is then transmitted via router 220 to any of a number of devices that support speech generation or reproduction. Such devices, for example, include without limitation telephone 225, pager 230, PDA 235, mobile telephone 240 and visualization workstation or computer 245. (Page 7, lines 18-28.)

Further, in addition to receiving requests and commands from visualization workstation 105, object repository 110 may receive requests and/or commands via command control component 250. Upon receiving an audio command from a device that supports speech generation or reproduction via router 220, speech recognition system 210 converts the audio command into command data that may operate as input to the command control component 250. The conversion of the audio command into command data may be accomplished using conventional speech processing techniques, known to one of ordinary skill in the art. As noted, speech recognition system 210 receives requests and/or commands in a verbal form from other devices, for example devices 225-245. Such commands may be in response to an alert generated by alert generation component 205. (Page 7, line 29 - page 8, line 9.)

Referring now to Figure 3, there is illustrated a flowchart describing the operation of one methodology for generating audio alerts. At block 305, an alert condition is detected within the IT enterprise. The alert condition may be detected by alert generation component 205 based on an event notification received from object repository 110. At block 310, alert generation component 205 determines a notification path associated with the detected alert condition. The notification path may direct that an alert be sent to one or more devices 210-245, and may be determined based on previous events, such as whether a prior alert has been generated without a response. (Page 8, lines 10-17.)

According to one embodiment of the present application, the determination of the notification path may be accomplished using a system for directing messages to different users depending on severity, type of object or any other parameter that may be the basis for filtering event notifications. Such a mechanism may be useful since many different types of messages, from many different contexts may be generated in a typical management system. A system for filtering messages is described in concurrently filed application entitled "Method and Apparatus for Filtering Messages Based on Context," which is incorporated herein in its entirety by reference. Further, the determination of the notification path may include

determining multiple paths to enable more than one user to be designated to receive a particular type of audio alert notification. (Page 8, lines 18-27.)

In addition to supporting the transmission of audio alert notifications to multiple users, the alert system 107 may also be configured to utilize an escalation list. An escalation list is a list of people to be notified for a particular class of message. The list may be stored in object repository 110, the management application 115, the alert generation component 205 or other storage facility. The list may be multi-tiered and may represent several levels of responsibility. For example, the list may include a first set of one or more operators who are primarily responsible for a particular alert, and a second set of one or more operators who are responsible if no one from the first set addresses the event within a particular period of time. Of course, the escalation list may be structured in a variety of ways, with any number of levels. (Page 8, line 28 - page 9, line 7.)

Given an escalation list with two operators, the list can be constructed, for example, such that if a first person on the escalation list does not respond to a phone message within five minutes, the second person on the list may be notified. In such an example, the alert system may deliver the following exemplary audio alert notification to a telephone associated with the second person: (Page 9, lines 8-12.)

"The NT server uschdb02 is predicted to begin thrashing within half an hour. We attempted to notify Sally Robinson, but she did not respond. You are responsible for handling this alert." (Page 9, lines 13-15.)

Some persons may be designated to be notified even if others have been given responsibility for handling a problem. For example, the alert system may deliver the following exemplary message to a manager: (Page 9, lines 17-19.)

"The NT server uschdb02 is predicted to begin thrashing within half an hour. This message is for information only. We have notified Bob Jones, who is the operator on duty and is responsible for handling this problem." (Page 9, lines 20-22.)

According to alternative embodiments of the present application, the management application 115 may include a facility for escalating the message to the next responsible manager if a problem is not addressed within a designated time limit, or if the same problem occurs several times within a designated time period. For example, the system may deliver the following message to the next responsible manager: (Page 9, lines 24-28.)

"The NT server uschdb02 has gone into thrashing three times within the past hour. We have notified Bob Jones, who is the operator on duty and is responsible for handling this problem." (Page 10, lines 1-3.)

The management system 100 may also be configured employ control logic for intelligently filtering and selectively providing audio alert notifications. Such filtering control logic may be useful to avoid an operating condition in which many audio alert notifications are provided within a narrow time period. In one embodiment, the system enables the user to define a personal filtering profile, so that only messages relevant to the user are sent. In alternative embodiments, the filtering may be based on one or more properties of the object(s) or alert message(s), including, for example, the type of the object(s), the name of the object(s) (including name patterns), the location of the object(s), the inclusion of the object in a business process view, as is described in commonly owned U.S. Patent Application Serial No. 09/545,024, filed April 7, 2000, which is incorporated herein in its entirety by reference. The filtering may also be based on the severity of the alert, the time of day, the level of risk in a predicted event, the importance of the object and/or the importance, severity, type, name, etc. of object(s) impacted by the problem, which is described in commonly owned, concurrently filed related U.S. Utility Patent Application entitled "Method and Apparatus for Filtering Messages Based on Content". (Page 10, lines 5-19.)

With continuing reference to Figure 3, at block 315, a notification message is constructed based, in part, on the parameters of the detected alert condition and other factors or conditions known in the art. The notification message may be constructed based on other additional factors. (Page 10, lines 20-23.)

In one embodiment of the present application, to facilitate user understanding of the audio alert notifications, some of the terms and names commonly used in an enterprise management system operator's lexicon may be modified. For example, an identifier for an operating system that is publicly known as "NT Server" may be stored in a database as the single word "NTServer", without any spaces separating the words. Such a single word identifier may be employed because many databases and programming languages do not permit spaces within an identifier. Further, users may use non-standard capitalization to aid in parsing non-standard words, and are adept at parsing such constructions even without the aid of capitalization. For example, "oraclev8" may be immediately recognized by an experienced user as referring to "Oracle Version 8". (Page 10, line 24 - page 11, line 3.)

The command/control system may incorporate a facility for storing, in the object repository 110 or in one or more other databases, a pronounceable version of technical names that a speech generation system cannot identify a word or phrase. Alternatively, user readable and pronounceable names, with the embedded spaces, may be utilized as the public names of components, and the command/control system automatically generates the internal, technically acceptable name. (Page 11, lines 4-9.)

At block 320, the audio characteristics of the notification message are defined based on the detected alert condition. Audio characteristics may include, for example, volume, panning, distortion and resolution. (Page 11, lines 10-12.)

When an operator sitting in front of a computer receives an audio alert notification through the computer's speaker system, the next step is often to navigate through the standard on-screen user interface to bring the relevant object up on screen, to allow further inspection of the situation. In typical user interfaces, such navigation may involve counter-intuitive clicking and scrolling. In some modern user interfaces, such as 3-D "virtual reality" views, infinitely pan able 2-D maps and hyperbolic trees, the navigation is a seamless movement in some direction. (Page 11, lines 13-19.)

According to one embodiment of the present application, to assist the user to immediately navigate to an object, speech generation component 215 may use stereo or surround-sound speakers to position the source of the sound in the right direction. If the operator is looking at a part of a map, and an alert message is presented from the right, it is natural to scroll the screen to the right. Consequently, the use of audio characteristics may enhance the utility of the present application. (Page 11, lines 20-25.)

At block 325, the notification message is output via the notification path. (Page 11, line 26.)

Referring now to Figures 2 and 4, the operation of one methodology for receiving an audio request/command will be described. At block 405, an audio request/command is received from a user. The audio request/command is received through router 220 by speech recognition component 210. The audio request/command is converted into command data (410) by speech recognition component 220. The resulting command data is then transmitted to command control component 250 for processing (415). (Page 11, line 27 - page 12, line 2.)

According to block 420, command control component 250 constructs a command based on the received command data. The command control component 250 transmits (425) the

generated command to object repository 110 where it is stored (430) until retrieved and executed by the network management application 115. (Page 12, lines 3-6.)

While the present disclosure has been described with reference to a network management application, the disclosed methodology and systems may also be applied to business applications such as order processing or credit validation which may be interfaced with a management system and to its alert management systems. Thus, in an alternate embodiment, if a business application generates alert messages when inventory levels get below a certain threshold or credit card fraud is detected, for example, then those messages can be delivered to any human manager through computer speakers, a telephone or other audio-based device. (Page 12, lines 7-14.)

It should also be appreciated that disclosed interface is not limited to operating in a single human language. Although alert notifications generated by management systems or applications are typically generated in a specific language, most often in English because of the domination of the IT industry by American companies, there are many multinational enterprises that use such systems which employ human operators who may speak other languages. Therefore, according to alternate embodiments of the present system, the system may include a facility for translating the message to a language designated for a specific recipient, and then generating the audio alert notification. (Page 12, lines 15-22.)

Accordingly, it is to be understood that the drawings and description in this disclosure are proffered to facilitate comprehension of the system, and should not be construed to limit the scope thereof. It should be understood that various changes, substitutions and alterations can be made without departing from the spirit and scope of the system. (Page 12, lines 23-27.)

It should be noted that this application is related to concurrently filed U.S. Non-Provisional Applications entitled "Method And Apparatus For Generating Context-Descriptive Messages" and "Method And Apparatus For Filtering Messages Based On Context" both of which are incorporated herein by reference in their entirety. This application is further related to U.S. Patent Nos. 5,958,012, 6,289,380 and 6,327,550, and co-pending U.S. Applications Serial Nos., 09/558,897, and 09/559,237, which are all incorporated in their entirety herein by reference. (Page 12, line 28 - page 13, line 4.)

Claim 1 recites:

A method for generating an audio alert and processing an audio command (e.g., Figure 3, reference numerals 305-325; Figure 4, reference numerals 405-430; Page 8, line 10 through Page 12, line 6), comprising:

- detecting an alert condition identifying a problem with a system component, the alert condition being detected in response to an event notification associated with at least one of a plurality of heterogeneous application subsystems, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are distinct from the one or more information technology management operations performed by other application subsystems in the plurality of heterogeneous application subsystems (e.g., Figure 3, reference numeral 305; Page 8, lines 10-13);

- filtering the alert condition to determine a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition, the object being stored in an object repository (e.g., Figure 3, reference numeral 310; Page 8, line 10 through Page 10, line 19);

- constructing an audio notification message based on at least one parameter associated with the alert condition (e.g., Figure 3, reference numerals 315 and 320; Page 8, lines 18-27; Page 10, line 20 through Page 11, line 25);

- outputting the audio notification message via the notification path (e.g., Figure 3, reference numeral 325; Page 11, line 26);

- receiving an audio command (e.g., Figure 4, reference numeral 405; Page 11, line 27 through Page 12, line 2);

- processing the audio command to derive command data (e.g., Figure 4, reference numeral 410; Page 11, line 27 through Page 12, line 6);

- constructing a command based on the command data (e.g., Figure 4, reference numeral 420; Page 11, line 27 through Page 12, line 6); and

- storing the command in the object repository (e.g., Figure 4, reference numeral 430; Page 12, lines 4-6).

Claim 13 recites:

A system for generating an audio alert and processing an audio command (e.g., Figures 1A, 1B, and 2, reference numerals 100, 150, and 108; Page 4, line 16 through Page 8, line 19); the system comprising:

- one or more memory units (e.g., Figures 1B and 2, reference numeral 110; Page 4, line 24 through Page 5, line 23; Page 6, lines 18-30); and

- one or more processing units (e.g., Figures 1B and 2, reference numeral 115; Page 4, line 22 through Page 5, lines 10; Page 6, line 18 through Page 8, line 9) operable to:

- detect an alert condition identifying a problem with a system component, the alert condition being detected in response to an event notification associated with at least one of a plurality of heterogeneous application subsystems, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are distinct from the one or more information technology management operations

performed by other application subsystems in the plurality of heterogeneous application subsystems (e.g., Figure 3, reference numeral 305; Page 8, lines 10-13);

filter the alert condition to determine a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition, the object being stored in an object repository (e.g., Figure 3, reference numeral 310; Page 8, line 10 through Page 10, line 19);

construct an audio notification message based on at least one parameter associated with the alert condition (e.g., Figure 3, reference numerals 315 and 320; Page 8, lines 18-27; Page 10, line 20 through Page 11, line 25);

output the audio notification message via the notification path (e.g., Figure 3, reference numeral 325; Page 11, line 26);

receive an audio command (e.g., Figure 4, reference numeral 405; Page 11, line 27 through Page 12, line 2);

process the audio command to derive command data (e.g., Figure 4, reference numeral 410; Page 11, line 27 through Page 12, line 6);

construct a command based on the command data (e.g., Figure 4, reference numeral 420; Page 11, line 27 through Page 12, line 6); and

store the command in the object repository (e.g., Figure 4, reference numeral 430; Page 12, lines 4-6).

Claim 15 recites:

A computer-readable storage medium encoded with processing instructions for generating an audio alert and processing an audio command (e.g., Figures 1A, 1B, and 2, reference numerals 100, 110, and 115; Page 4, line 16 through Page 6, line 17; Page 11, line 27 through Page 12, line 14), including:

computer readable instructions for detecting an alert condition identifying a problem with a system component, the alert condition being detected in response to an event notification associated with at least one of a plurality of heterogeneous application subsystems, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are distinct from the one or more information technology management operations performed by other application subsystems in the plurality of heterogeneous application subsystems (e.g., Figure 3, reference numeral 305; Page 8, lines 10-13);

computer readable instructions for filtering the alert condition to determine a notification path associated with the alert condition, the notification path determined based at least on a property of an object associated with the alert condition, the object being stored in an object repository (e.g., Figure 3, reference numeral 310; Page 8, line 10 through Page 10, line 19);

computer readable instructions for constructing an audio notification message based on at least one parameter associated with the alert condition (e.g., Figure 3, reference numerals 315 and 320; Page 8, lines 18-27; Page 10, line 20 through Page 11, line 25);

computer readable instructions for outputting the audio notification message via the notification path (e.g., Figure 3, reference numeral 325; Page 11, line 26);

computer readable instructions for receiving an audio command (e.g., Figure 4, reference numeral 405; Page 11, line 27 through Page 12, line 2);

computer readable instructions for processing the audio command to derive command data (e.g., Figure 4, reference numeral 410; Page 11, line 27 through Page 12, line 6);

computer readable instructions for constructing a command based on the command data (e.g., Figure 4, reference numeral 420; Page 11, line 27 through Page 12, line 6); and

computer readable instructions for storing the command in the object repository (e.g., Figure 4, reference numeral 430; Page 12, lines 4-6).

Dependent Claim 3 incorporates the elements of Claim 1, and further recites the following:

wherein constructing an audio notification message includes identifying a portion of the message that is likely to be difficult for a user to understand and replacing the identified portion with a more easily understood synonym (e.g., Figure 3, reference numerals 315 and 320; Page 10, line 5 through Page 11, line 9).

Dependent Claim 19 incorporates the elements of Claim 1, and further recites the following:

the notification path comprises a multi-tiered notification path, each tier of the multi-tiered notification path identifying one or more users assigned a level of responsibility with respect to the alert condition; and

the method further comprises assigning the level of responsibility to each of the one or more users based upon a type of object associated with the alert condition (e.g., Figure 3, reference numeral 310; Page 8, line 18 through Page 10, line 4).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Are Claims 1, 4, 13, 15, and 20 unpatentable over U.S. Patent No. 5,367,670 issued to Ward et al. ("*Ward*") in view of U.S. Patent No. 6,603,396 issued to Lewis et al. ("*Lewis*"), and further in view of U.S. Patent No. 5,745,692 to Lohmann II et al. ("*Lohmann*") under 35 U.S.C. § 103(a)?

Is Claim 3 unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of U.S. Patent No. 6,037,099 to Sabourin, et al. ("*Sabourin*") under 35 U.S.C. § 103(a)?

Is Claim 19 unpatentable over *Ward*, *Lewis*, and *Lohmann*, and *Cote* in view of U.S. Patent Publication No. 2004/0210469 filed by Jones et al. ("*Jones*") under 35 U.S.C. § 103(a)?

Are Claims 9, 17, 21, and 22 unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of *Cote* under 35 U.S.C. § 103(a)?

Are Claims 5 and 6 unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of U.S. Patent No. 4,881,197 to Fischer ("*Fischer*") under 35 U.S.C. § 103(a)?

Is Claim 8 unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of U.S. Patent No. 6,421,707 to Miller, et al. ("*Miller*") under 35 U.S.C. § 103(a)?

Is Claim 11 unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of U.S. Patent No. 6,161,082 to Goldberg, et al. ("*Goldberg*") under 35 U.S.C. § 103(a)?

Is Claim 7 unpatentable over *Ward*, *Lewis*, *Lohmann*, and *Fischer* in view of Official Notice under 35 U.S.C. § 103(a)?

Is Claim 10 unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of *Cote* and further in view of U.S. Patent Publication No. 2001/0044840 filed by Carleton ("*Carleton*") under 35 U.S.C. § 103(a)?

Is Claim 18 unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of *Cote* and further in view of *Jones* under 35 U.S.C. § 103(a)?

Are Claims 23 and 24 unpatentable over *Ward*, *Lewis*, and *Lohmann* in view of *Cote* and further in view of U.S. Patent No. 6,185,613 to Lawson, et al. ("*Lawson*") under 35 U.S.C. § 103(a)?

ARGUMENTS

Claims 1, 3-11, 13, 15, and 17-24 are pending in the Application. Appellant respectfully requests reconsideration and allowance of all pending claims. Claims 2, 12, 14, and 16 have been cancelled. As explained below, Appellant believes all claims to be allowable over the cited references. Accordingly, Appellant submits that these rejections are improper and should be reversed by the Board. Appellant addresses independent Claims 1, 13, and 15 and dependent Claims 3, 5-11, 17-19, and 21-24 below.

I. The Legal Standard for Obviousness

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. One of the three basic criteria that must be established by an Examiner to establish a *prima facie* case of obviousness is that “the prior art reference (or references when combined) must teach or suggest ***all the claim limitations***.” See M.P.E.P. § 706.02(j) citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (emphasis added). “***All words*** in a claim must be considered in judging the patentability of that claim against the prior art.” See M.P.E.P. § 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added).

In addition, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole still cannot be said to be obvious without some reason why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The controlling case law, rules, and guidelines repeatedly warn against using an Appellant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon Appellant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142.

The U.S. Supreme Court’s decision in *KSR Int’l Co. v. Teleflex, Inc.* reiterated the requirement that Examiners provide an explanation as to why the claimed invention would have been obvious. *KSR Int’l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). The analysis

regarding an apparent reason to combine the known elements in the fashion claimed in the patent at issue “should be made explicit.” *KSR*, 127 S.Ct. at 1740-41. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* at 1741 (internal quotations omitted).

The new examination guidelines issued by the PTO in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted). The guidelines further describe a number of rationales that, in the PTO’s view, can support a finding of obviousness. *Id.* at 57529-34. The guidelines set forth a number of particular findings of fact that must be made and explained by the Examiner to support a finding of obviousness based on one of those rationales. *See id.*

II. Claims 1, 4, 13, 15, and 20 are allowable under 35 U.S.C. § 103(a) over the proposed *Ward-Lewis-Lohmann* combination

Independent Claim 1, as presented on Appeal, recites:

A method for generating an audio alert and processing an audio command, comprising:

detecting an alert condition identifying a problem with a system component, the alert condition being detected in response to an event notification associated with at least one of a plurality of heterogeneous application subsystems, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are distinct from the one or more information technology management operations performed by other application subsystems in the plurality of heterogeneous application subsystems;

filtering the alert condition to determine a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition, the object being stored in an object repository;

constructing an audio notification message based on at least one parameter associated with the alert condition;

outputting the audio notification message via the notification path;

receiving an audio command;

processing the audio command to derive command data;

constructing a command based on the command data;

and

storing the command in the object repository.

Appellant submits that the *Ward-Lewis-Lohmann* combination suggested by the Examiner fails to teach, suggest, or disclose each of these limitations.

- A. The cited references do not disclose “*filtering the alert condition to determine a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition*” and “*outputting the audio notification message via the notification path.*”**

For example, the *Ward-Lewis-Lohmann* combination fails to teach, suggest, or disclose “filtering the alert condition to determine a notification path associated with the alert condition, **the notification path being determined based at least on a property of an object associated with the alert condition**” and then “outputting the audio notification message **via the notification path**.” In the *Final Office Action*, the Examiner relies upon *Ward* as disclosing the “filtering” limitation. (*Final Office Action*, pp. 3-4 (citing *Ward*, col. 5, ll. 21-27)). However, the Examiner is incorrect. As stated above, Appellant’s claim requires that a notification path be “determined based at least on a property of an object associated with the alert condition.” The four “paths” in the cited portion of *Ward*, as identified by the Examiner, fail to satisfy this requirement.

Instead, *Ward* merely discloses:

As may be seen in FIG. 2, the path by which data accumulated during the monitoring of system components and parameters indicative of an actual or potential failure may be any one of four paths, depending on the particular type of actual or potential failure being monitored. Each system component being monitored may be referred to as an object having a number of attributes.

(*Ward*, col. 5, ll. 21-27). “When the attributes exceed their boundary or threshold values, an alert will be generated.” (*Ward*, col. 5, ll. 31-32). “Examples of alert conditions . . . include loss of system power, server subsystem failure, [and] excessive server temperature as well as other configurable events that require outside attention.” (*Ward*, col. 7, ll. 19-24). Once it is determined that an alert should be issued, “an alert can be issued in a number of ways.” (*Ward*, col. 7, ll. 25-27). In particular, the alert may be delivered “in-band” or “out-of-band.” (*Ward*, at col. 7, ll. 28-29). More particularly, “out-of band” alerts may be delivered by “sending a protocol message over a switched telephone connection to the system manager facility 34, by dialing a phone number associated with a pager 56 or by dialing a phone number to a phone 58 associated with a person and generating a synthesized voice message upon completing a connection with the phone 58.” (*Ward*, col. 7, ll. 50-57).

According to the Examiner, the methods of delivering these three “out-of-bound” alerts and the “in-band” alerts are the four paths referenced in col. 5, ll. 21-27 of *Ward*. (*Final Office Action*, p. 20). However, these four paths are not “notification paths” as recited in Claim 1. At best, *Ward* discloses that data may be gathered by one of four paths and then

an alert message may be sent to a system manager. Nowhere does *Ward* disclose determination of a notification path “based at least on a property of an object associated with the alert condition,” as recited in Claim 1. Instead, the mention of “paths” in *Ward* relates to “the path by which data accumulated during the monitoring of system components” depending on the particular type of failure. (*Ward*, col. 5, ll. 21-27). As such, the path disclosed in *Ward* does not relate to any “notification path,” as recited in Claim 1. Moreover, this disclosure falls well short of teaching, suggesting, or disclosing that the paths are “determined **based at least on a property of an object** associated with the alert condition” as recited in Claim 1. Simply put, *Ward* fails to teach, suggest or disclose this limitation.

For at least this reason, the rejection of Claim 1 is improper.

- B. The cited references do not disclose “*the alert condition being detected in response to an event notification associated with at least one of a plurality of heterogeneous application subsystems, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are distinct from the one or more information technology management operations performed by the other application subsystems in the plurality of heterogeneous application subsystems.*”**

As an additional distinction, the *Ward-Lewis-Lohmann* combination fails to teach, suggest, or disclose “the alert condition being detected in response to an event notification associated with at least one of **a plurality of heterogeneous application subsystems**, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are **distinct** from the one or more information technology management operations performed by the other application subsystems in the plurality of heterogeneous application subsystems,” as recited in Claim 1. In the *Final Office Action*, the Examiner relies upon the various system components monitored by system manager 22 of *Ward* for disclosure of the recited claim elements. (*Final Office Action*, pp. 3, 21). These system components include “server subsystems, asynchronous serial port, the computer system bus 13, and the intelligent disk array controller device 26.” (*Final Office Action*, p. 21). However, these system components are not “heterogeneous application subsystems” as recited in Claim 1.

Claim 1 explicitly states that each heterogeneous application subsystem must “perform[] an associated one or more information technology management operations that are distinct from the one or more information technology management operations performed by the other application subsystems in the plurality of heterogeneous application subsystems.” The system components in *Ward* cited by the Examiner fail to satisfy this limitation. In fact, the cited components are all part the same server 12 (the EISA server) shown in Figures 1 and 3 of *Ward*. As such, they do not perform distinct information technology management operations. Instead, they perform interrelated operations for the same EISA server.

For at least these additional reasons, the rejection of Claim 1 is improper.

C. The Proposed *Ward-Lewis-Lohmann* Combination is Improper

Applicant respectfully submits that the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant’s invention to modify or combine *Ward*, *Lewis*, and *Lohmann* in the manner the Examiner proposes. Applicant’s claims are allowable for at least this additional reason.

With respect to the proposed combination of *Lewis* with *Ward*, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*’s teaching would allow *Ward*’s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention (*without using Applicant’s disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant’s invention would have actually

done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, “Specifically, Lewis’ teaching of filtering out and discarding irrelevant alarms would the performance and reliability of only relevant alarms being passed.” (*Final Office Action*, page 22). It is not clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant’s claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing “filtering the alert condition to determine a notification path,” as recited in Claim 1. It is not clear to Applicant how “filtering out and discarding irrelevant alarms” to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses “filtering an alert condition to determine a notification path associated with the alert condition,” as argued by the Examiner, it is entirely unclear why the alleged motivation of “maximizing performance and reliability of the system” would lead one of ordinary skill in the art at the time of Applicant’s invention to incorporate the teaching of “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of “maximizing performance and reliability of the system” would even be achieved by modifying the system of *Ward* to include “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining.

Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*. Applicant respectfully submits that the Examiner’s conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner’s attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant’s claims, using

Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Applicant respectfully submits that the proposed *Ward-Lewis-Lohmann* combination is improper. Independent Claims 1, 13, and 15 and their dependent claims are allowable for at least this additional reason.

D. Conclusions

Appellant has shown above that the proposed *WardLewis-Lohmann* combination does not disclose, teach, or suggest at least two claim limitations recited in Appellant's Claim 1. Additionally, Appellant has shown that the proposed combination of references is improper. Accordingly, Appellant respectfully requests that the rejection of Claim 1 (together with Claims 4 and 20 that depend from Claim 1) be withdrawn. Similar to Claim 1, Claims 13 and 15 each recite "a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition" and "a plurality of heterogeneous application subsystems, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are distinct from the one or more information technology management operations performed by other application subsystems in the plurality of heterogeneous application subsystems." Therefore, Appellant submits that Claims 13 and 15 are allowable at least for reasons similar to those discussed above with regard to Claim 1.

III. Claim 3 is allowable under 35 U.S.C. § 103(a) over the proposed *Ward-Lewis-Lohmann-Sabourin* combination

Claim 3 depends from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann-Sabourin* combination, and is allowable for at least this reason.

A. The cited references do not disclose the elements of Claim 3

First, Claim 3 recites further patentable distinctions over the proposed combination of references.

For example, Claim 3 recites:

wherein constructing an audio notification message includes identifying a portion of the message that is likely to be difficult for a user to understand and replacing the identified portion with a more easily understood synonym.

Appellant submits that the *Ward-Lewis-Lohmann-Sabourin* combination suggested by the Examiner fails to teach, suggest, or disclose each of these limitations.

In the *Final Office Action*, the Examiner acknowledges that *Ward*, *Lewis*, and *Lohmann* fail to disclose these limitations and instead argues that *Sabourin* teaches these limitations. (*Final Office Action*, pages 9-10). In particular, the Examiner cites column 10, line 60 through column 11, line 8 of *Sabourin* as allegedly teaching the limitations of Claim 3. (*Final Office Action*, page 10). However, the cited portion of *Sabourin* actually relates to computer recognition of human speech and an associated confusability tool that appears to be the subject of the alleged invention in *Sabourin*. (*Sabourin*, Col. 10, l. 60 through Col. 11, l. 8). The cited portion discloses that there is some flexibility in the selection of the lexicon the computer is trained to recognize. (*Sabourin*, Col. 10, l. 60 through Col. 11, l. 8). According to *Sabourin*, the confusability tool may be used to automatically find word pairings that tend to cause high confusability, and a designer can replace the relevant orthographies with alternate synonyms. (*Sabourin*, Col. 10, l. 60 through Col. 11, l. 8). *Sabourin* further discloses that the simplification of a lexicon by replacing confusable words with non-confusable synonyms can be useful by facilitating understanding across a communication medium and for creating a

confusable test lexicon to rigorously test a speech recognizer. (*Sabourin*, Col. 10, l. 60 through Col. 11, l. 8).

However, nowhere does the cited portion disclose, teach, or suggest constructing an audio notification message by identifying a portion of the message that is likely to be difficult for a user to understand and replacing the identified portion with a more easily understood synonym, as recited in Claim 3. The cited portions of *Sabourin* relate to computer recognition of human speech; they do not disclose, teach, or suggest constructing an audio notification message by identifying a portion of the message that is likely to be difficult for a user to understand and replacing the identified portion with a more easily understood synonym. Accordingly, *Sabourin* and the proposed *Ward-Lewis-Lohmann-Sabourin* combination does not disclose, teach, or suggest that “constructing an audio notification message includes identifying a portion of the message that is likely to be difficult for a user to understand and replacing the identified portion with a more easily understood synonym,” as recited in Appellant’s Claim 3.

For at least this reason, the rejection of Claim 3 is improper.

B. The Proposed *Ward-Lewis-Lohmann-Sabourin* Combination is Improper

Applicant respectfully submits that the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant’s invention to modify or combine *Ward*, *Lewis*, *Lohmann*, and *Sabourin* in the manner the Examiner proposes. Applicant’s claims are allowable for at least this additional reason.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim from which Claim 3 depends, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Ward and Lewis because Lewis’s teaching would allow Ward’s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not

admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, Lewis' teaching of filtering out and discarding irrelevant alarms would the performance and reliability of only relevant alarms being passed." (*Final Office Action*, page 22). It is not clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant's claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing "filtering the alert condition to determine a notification path," as recited in Claim 1. It is not clear to Applicant how "filtering out and discarding irrelevant alarms" to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses "filtering an alert condition to determine a notification path associated with the alert condition," as argued by the Examiner, it is entirely unclear why the alleged motivation of "maximizing performance and reliability of the system" would lead one of ordinary skill in the art at the time of Applicant's invention to incorporate the teaching of "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of "maximizing performance and reliability of the system" would even be achieved by modifying the system of *Ward* to include "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly

taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining.

Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*. Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant's claims, using Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Applicant respectfully submits that the proposed *Ward-Lewis-Lohmann* combination is improper. Dependent Claim 3 is allowable for at least these additional reasons.

C. Conclusions

Appellant has shown above that the proposed *Ward-Lewis-Lohmann-Sabourin* combination does not disclose, teach, or suggest the limitations recited in Appellant's Claim 3. Additionally, Appellant has shown that the proposed combination of references is improper. Accordingly, Appellant respectfully requests that the rejection of Claim 3 be withdrawn.

IV. Claim 19 is allowable under 35 U.S.C. § 103(a) over the proposed *Ward-Lewis-Lohmann-Cote-Jones* combination

Claim 19 depends from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann-Cote-Jones* combination, and is allowable for at least this reason.

A. The cited references do not disclose the elements of Claim 19

First, Claim 19 recites further patentable distinctions over the proposed combination of references. For example, Claim 19 recites:

- the notification path comprises a multi-tiered notification path, each tier of the multi-tiered notification path identifying one or more users assigned a level of responsibility with respect to the alert condition; and
- the method further comprises assigning the level of responsibility to each of the one or more users ***based upon a type of object associated with the alert condition.***

Appellant submits that the *Ward-Lewis-Lohmann-Cote-Jones* combination suggested by the Examiner fails to teach, suggest, or disclose each of these limitations.

As allegedly disclosing the second limitation, the Examiner cites *Jones*, stating that *Jones* “teaches assigning the level of responsibility to each of the one or more users based upon the severity of the alert condition (i.e., type of object associated with the alert condition).” (*Final Office Action*, page 13). Appellant respectfully submits, however, that the severity of the alert condition cannot be equated with the “type of object associated with the alert condition,” as it is recited in Claim 19. It appears that the Examiner has rejected Claim 19 under the same basis that Claim 18 is rejected. As such, Appellant submits that the Examiner is not giving credence to each element of Appellant’s Claim 19. The M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Whereas Claim 18 recites that the level of responsibility is assigned “based upon the severity of the alert condition,” Claim 19 specifically recites that the level of responsibility is assigned “based upon the type of object associated with the alert condition.” Thus, rejection of Claim 19 is improper at least because

the Examiner has not given consideration to the particular claim elements recited in Claim 19.

Additionally, as purportedly disclosing the “object” recited in Applicant’s claims, the Examiner relies on the objects disclosed in *Ward*, which appear to represent system components. Now, in rejecting Claim 19, the Examiner improperly modifies what is being mapped to the claimed “object.” Respectfully, this type of inconsistency is no doubt the result of attempting to combine disjointed portions of too many references in an attempt to recreate Applicant’s claims through hindsight. The cited portion of *Jones* does not disclose, teach, or suggest “assigning the level of responsibility to each of the one or more users ***based upon a type of object associated with the alert condition,***” as recited in Claim 19.

Appellant reiterates that “[t]o establish *prima facie* obviousness of a claimed invention, ***all the claim limitations*** must be taught or suggested by the prior art.” M.P.E.P. § 2143.03 (emphasis added). “***All words*** in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. 2143.03 (emphasis added). It does not appear to Applicant that the cited portions of the proposed *Ward-Lewis-Lohmann-Cote-Jones* discloses, teaches, or suggests, at a minimum, “assigning the level of responsibility to each of the one or more users based upon a type of object associated with the alert condition,” as recited in Claim 19.

For at least this reason, the rejection of Claim 3 is improper.

B. The Proposed *Ward-Lewis-Lohmann-Cote-Jones* Combination is Improper

Applicant respectfully submits that the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant’s invention to modify or combine *Ward*, *Lewis*, *Lohmann*, *Cote*, and *Jones* in the manner the Examiner proposes. Applicant’s claims are allowable for at least these additional reasons.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim from which Claim 3 depends, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*’s teaching would allow *Ward*’s system to filter irrelevant

alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, *Lewis*' teaching of filtering out and discarding irrelevant alarms would the performance and reliability of only relevant alarms being passed." (*Final Office Action*, page 22). It is not clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant's claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing "filtering the alert condition to determine a notification path," as recited in Claim 1. It is not clear to Applicant how "filtering out and discarding irrelevant alarms" to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses "filtering an alert condition to determine a notification path associated with the alert condition," as argued by the Examiner, it is entirely unclear why the alleged motivation of "maximizing performance and reliability of the system" would lead one of ordinary skill in the art at the time of Applicant's invention to incorporate the teaching of "filtering an alert condition to determine a notification path associated with the alert

condition,” as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of “maximizing performance and reliability of the system” would even be achieved by modifying the system of *Ward* to include “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*.

Furthermore, Appellant respectfully notes that to reject Appellant’s claim, the Examiner pieces together bits and pieces of five separate references. Even if the cited references disclose the elements alleged by the Examiner (which Appellant does not admit and has expressly disputed above), such a piecemeal rejection of Appellant’s claim language fails to give credence to the particular combination of features recited in Appellant’s claim. Appellant respectfully submits that a rejection of Claim 19 under the *Ward-Lewis-Lohmann-Cote-Jones* combination, in the manner provided by the Examiner, can only result from piecing together disjointed portions of five unrelated references to reconstruct Applicants’ claims with the benefit of hindsight.

The Federal Circuit has made clear that is improper for an Examiner to use hindsight having read the Applicant’s disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, Appellant respectfully submits that the Examiner has used Appellant’s claimed invention as an instruction manual to combining the teachings of *Ward*, *Lewis*, *Lohmann*, *Cote*, and *Jones* to conclude that the references disclose the elements of Claim 19. Because the hindsight reconstruction of Appellant’s claim is improper, Claim 19 is allowable over the proposed *Ward-Lewis-Lohmann-Cote-Jones* combination.

Appellant respectfully submits that the Examiner’s conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner’s attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant’s claims, using Appellant’s claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellant respectfully submits that the proposed *Ward-Lewis-Lohmann-Cote-Jones* combination is improper. Dependent Claim 19 is allowable for at least these additional reasons.

C. Conclusions

Appellant has shown above that the proposed *Ward-Lewis-Lohmann-Cote-Jones* combination does not disclose, teach, or suggest the limitations recited in Appellant's Claim 19. Additionally, Appellant has shown that the proposed combination of references is improper. Accordingly, Appellant respectfully requests that the rejection of Claim 19 be withdrawn.

V. Claims 9, 17, 21, and 22 are allowable under 35 U.S.C. § 103(a) over *Ward, Lewis, and Lohmann* in view of *Cote*?

Claims 9, 17, 21, and 22 depend from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann* combination. Claims 9, 17, 21, and 22 are allowable for at least because the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine the cited references in the manner the Examiner proposes. Applicant's claims are allowable for at least these additional reasons.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, *Lewis*' teaching of filtering out and discarding irrelevant alarms would the performance and

reliability of only relevant alarms being passed.” (*Final Office Action*, page 22). It is not clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant’s claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing “filtering the alert condition to determine a notification path,” as recited in Claim 1. It is not clear to Applicant how “filtering out and discarding irrelevant alarms” to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses “filtering an alert condition to determine a notification path associated with the alert condition,” as argued by the Examiner, it is entirely unclear why the alleged motivation of “maximizing performance and reliability of the system” would lead one of ordinary skill in the art at the time of Applicant’s invention to incorporate the teaching of “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of “maximizing performance and reliability of the system” would even be achieved by modifying the system of *Ward* to include “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*.

Furthermore, Appellant respectfully notes that to reject Appellant’s dependent claims, the Examiner pieces together bits and pieces of ten separate references. Even if the cited references disclose the elements alleged by the Examiner (which Appellant does not admit and has expressly disputed above), such a piecemeal rejection of Appellant’s claim language fails to give credence to the particular combination of features recited in Appellant’s claim. Appellant respectfully submits that a rejection of Claims 9, 17, 21, and 22 under the proposed combinations, in the manner provided by the Examiner, can only result from piecing together disjointed portions of ten unrelated references to reconstruct Appellant’s claims with the benefit of hindsight.

The Federal Circuit has made clear that is improper for an Examiner to use hindsight having read the Applicant’s disclosure to arrive at an obviousness rejection. *In re Fine*, 837

F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, Appellant respectfully submits that the Examiner has used Appellant's claimed invention as an instruction manual to combining the teachings of *Ward*, *Lewis*, *Lohmann*, and *Cote* to conclude that the references disclose the elements of Claims 9, 17, 21, and 22. Because the hindsight reconstruction of Appellant's claim is improper, Claims 9, 17, 21, and 22 are allowable over the proposed combinations of references.

Appellant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant's claims, using Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellant respectfully submits that the proposed *Ward-Lewis-Lohmann-Cote* combination is improper.

VI. Claims 5 and 6 are allowable under 35 U.S.C. § 103(a) over *Ward, Lewis, and Lohmann* in view of *Fischer*?

Claims 5 and 6 depend from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann-Fischer* combination. Claims 5 and 6 are allowable for at least because the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine the cited references in the manner the Examiner proposes. Applicant's claims are allowable for at least these additional reasons.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, *Lewis*' teaching of filtering out and discarding irrelevant alarms would the performance and

reliability of only relevant alarms being passed.” (*Final Office Action*, page 22). It is not clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant’s claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing “filtering the alert condition to determine a notification path,” as recited in Claim 1. It is not clear to Applicant how “filtering out and discarding irrelevant alarms” to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses “filtering an alert condition to determine a notification path associated with the alert condition,” as argued by the Examiner, it is entirely unclear why the alleged motivation of “maximizing performance and reliability of the system” would lead one of ordinary skill in the art at the time of Applicant’s invention to incorporate the teaching of “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of “maximizing performance and reliability of the system” would even be achieved by modifying the system of *Ward* to include “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*.

Furthermore, Appellant respectfully notes that to reject Appellant’s dependent claims, the Examiner pieces together bits and pieces of ten separate references. Even if the cited references disclose the elements alleged by the Examiner (which Appellant does not admit and has expressly disputed above), such a piecemeal rejection of Appellant’s claim language fails to give credence to the particular combination of features recited in Appellant’s claim. Appellant respectfully submits that a rejection of Claims 5 and 6 under the proposed combination, in the manner provided by the Examiner, can only result from piecing together disjointed portions of ten unrelated references to reconstruct Appellant’s claims with the benefit of hindsight.

The Federal Circuit has made clear that is improper for an Examiner to use hindsight having read the Applicant’s disclosure to arrive at an obviousness rejection. *In re Fine*, 837

F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, Appellant respectfully submits that the Examiner has used Appellant's claimed invention as an instruction manual to combining the teachings of *Ward*, *Lewis*, *Lohmann*, and *Fischer* to conclude that the references disclose the elements of Claims 5 and 6. Because the hindsight reconstruction of Appellant's claim is improper, Claims 5 and 6 are allowable over the proposed combinations of references.

Appellant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant's claims, using Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellant respectfully submits that the proposed *Ward-Lewis-Lohmann-Fischer* combination is improper.

VII. Claim 8 is allowable under 35 U.S.C. § 103(a) over *Ward, Lewis, and Lohmann* in view of *Miller*?

Claim 8 depends from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann-Miller* combination. Claim 8 is allowable at least because the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine the cited references in the manner the Examiner proposes. Applicant's claims are allowable for at least these additional reasons.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, *Lewis*' teaching of filtering out and discarding irrelevant alarms would the performance and reliability of only relevant alarms being passed." (*Final Office Action*, page 22). It is not

clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant's claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing "filtering the alert condition to determine a notification path," as recited in Claim 1. It is not clear to Applicant how "filtering out and discarding irrelevant alarms" to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses "filtering an alert condition to determine a notification path associated with the alert condition," as argued by the Examiner, it is entirely unclear why the alleged motivation of "maximizing performance and reliability of the system" would lead one of ordinary skill in the art at the time of Applicant's invention to incorporate the teaching of "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of "maximizing performance and reliability of the system" would even be achieved by modifying the system of *Ward* to include "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*.

Furthermore, Appellant respectfully notes that to reject Appellant's dependent claims, the Examiner pieces together bits and pieces of ten separate references. Even if the cited references disclose the elements alleged by the Examiner (which Appellant does not admit and has expressly disputed above), such a piecemeal rejection of Appellant's claim language fails to give credence to the particular combination of features recited in Appellant's claim. Appellant respectfully submits that a rejection of Claim 8 under the proposed combination, in the manner provided by the Examiner, can only result from piecing together disjointed portions of ten unrelated references to reconstruct Appellant's claims with the benefit of hindsight.

The Federal Circuit has made clear that is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed

invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, Appellant respectfully submits that the Examiner has used Appellant's claimed invention as an instruction manual to combining the teachings of *Ward*, *Lewis*, *Lohmann*, and *Miller* to conclude that the references disclose the elements of Claim 8. Because the hindsight reconstruction of Appellant's claim is improper, Claim 8 is allowable over the proposed combination of references.

Appellant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant's claims, using Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellant respectfully submits that the proposed *Ward-Lewis-Lohmann-Miller* combination is improper.

VIII. Claim 11 is allowable under 35 U.S.C. § 103(a) over *Ward, Lewis, and Lohmann* in view of *Goldberg*?

Claim 11 depends from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann-Goldberg* combination. Claim 11 is allowable at least because the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine the cited references in the manner the Examiner proposes. Applicant's claims are allowable for at least these additional reasons.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, *Lewis*' teaching of filtering out and discarding irrelevant alarms would the performance and reliability of only relevant alarms being passed." (*Final Office Action*, page 22). It is not

clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant's claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing "filtering the alert condition to determine a notification path," as recited in Claim 1. It is not clear to Applicant how "filtering out and discarding irrelevant alarms" to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses "filtering an alert condition to determine a notification path associated with the alert condition," as argued by the Examiner, it is entirely unclear why the alleged motivation of "maximizing performance and reliability of the system" would lead one of ordinary skill in the art at the time of Applicant's invention to incorporate the teaching of "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of "maximizing performance and reliability of the system" would even be achieved by modifying the system of *Ward* to include "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*.

Furthermore, Appellant respectfully notes that to reject Appellant's dependent claims, the Examiner pieces together bits and pieces of ten separate references. Even if the cited references disclose the elements alleged by the Examiner (which Appellant does not admit and has expressly disputed above), such a piecemeal rejection of Appellant's claim language fails to give credence to the particular combination of features recited in Appellant's claim. Appellant respectfully submits that a rejection of Claim 11 under the proposed combination, in the manner provided by the Examiner, can only result from piecing together disjointed portions of ten unrelated references to reconstruct Appellant's claims with the benefit of hindsight.

The Federal Circuit has made clear that is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed

invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, Appellant respectfully submits that the Examiner has used Appellant's claimed invention as an instruction manual to combining the teachings of *Ward*, *Lewis*, *Lohmann*, and *Goldberg* to conclude that the references disclose the elements of Claim 11. Because the hindsight reconstruction of Appellant's claim is improper, Claim 11 is allowable over the proposed combination of references.

Appellant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant's claims, using Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellant respectfully submits that the proposed *Ward-Lewis-Lohmann-Goldberg* combination is improper.

IX. Claim 7 is allowable under 35 U.S.C. § 103(a) over *Ward, Lewis, and Lohmann* in view of *Fischer* in further view of Official Notice?

Claim 7 depends from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann-Fischer-Official Notice* combination. Claim 7 is allowable at least because the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine the cited references in the manner the Examiner proposes. Applicant's claims are allowable for at least these additional reasons.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, *Lewis*' teaching of filtering out and discarding irrelevant alarms would the performance and

reliability of only relevant alarms being passed.” (*Final Office Action*, page 22). It is not clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant’s claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing “filtering the alert condition to determine a notification path,” as recited in Claim 1. It is not clear to Applicant how “filtering out and discarding irrelevant alarms” to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses “filtering an alert condition to determine a notification path associated with the alert condition,” as argued by the Examiner, it is entirely unclear why the alleged motivation of “maximizing performance and reliability of the system” would lead one of ordinary skill in the art at the time of Applicant’s invention to incorporate the teaching of “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of “maximizing performance and reliability of the system” would even be achieved by modifying the system of *Ward* to include “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*.

Furthermore, Appellant respectfully notes that to reject Appellant’s dependent claims, the Examiner pieces together bits and pieces of ten separate references. Even if the cited references disclose the elements alleged by the Examiner (which Appellant does not admit and has expressly disputed above), such a piecemeal rejection of Appellant’s claim language fails to give credence to the particular combination of features recited in Appellant’s claim. Appellant respectfully submits that a rejection of Claim 7 under the proposed combination, in the manner provided by the Examiner, can only result from piecing together disjointed portions of ten unrelated references to reconstruct Appellant’s claims with the benefit of hindsight.

The Federal Circuit has made clear that is improper for an Examiner to use hindsight having read the Applicant’s disclosure to arrive at an obviousness rejection. *In re Fine*, 837

F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, Appellant respectfully submits that the Examiner has used Appellant's claimed invention as an instruction manual to combining the teachings of *Ward*, *Lewis*, *Lohmann*, and *Fischer* and *Official Notice* to conclude that the references disclose the elements of Claim 7. Because the hindsight reconstruction of Appellant's claim is improper, Claim 7 is allowable over the proposed combination of references.

Appellant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant's claims, using Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellant respectfully submits that the proposed *Ward-Lewis-Lohmann-Fischer-Official Notice* combination is improper.

X. Claim 10 is allowable under 35 U.S.C. § 103(a) over *Ward, Lewis, and Lohmann* in view of *Cote* and further in view of *Carleton*?

Claim 10 depends from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann-Cote-Carleton* combination. Claim 10 is allowable at least because the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine the cited references in the manner the Examiner proposes. Applicant's claims are allowable for at least these additional reasons.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, *Lewis*' teaching of filtering out and discarding irrelevant alarms would the performance and reliability of only relevant alarms being passed." (*Final Office Action*, page 22). It is not

clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant's claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing "filtering the alert condition to determine a notification path," as recited in Claim 1. It is not clear to Applicant how "filtering out and discarding irrelevant alarms" to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses "filtering an alert condition to determine a notification path associated with the alert condition," as argued by the Examiner, it is entirely unclear why the alleged motivation of "maximizing performance and reliability of the system" would lead one of ordinary skill in the art at the time of Applicant's invention to incorporate the teaching of "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of "maximizing performance and reliability of the system" would even be achieved by modifying the system of *Ward* to include "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*.

Furthermore, Appellant respectfully notes that to reject Appellant's dependent claims, the Examiner pieces together bits and pieces of ten separate references. Even if the cited references disclose the elements alleged by the Examiner (which Appellant does not admit and has expressly disputed above), such a piecemeal rejection of Appellant's claim language fails to give credence to the particular combination of features recited in Appellant's claim. Appellant respectfully submits that a rejection of Claim 10 under the proposed combination, in the manner provided by the Examiner, can only result from piecing together disjointed portions of ten unrelated references to reconstruct Appellant's claims with the benefit of hindsight.

The Federal Circuit has made clear that is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed

invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, Appellant respectfully submits that the Examiner has used Appellant's claimed invention as an instruction manual to combining the teachings of *Ward*, *Lewis*, *Lohmann*, *Cote*, and *Carleton* to conclude that the references disclose the elements of Claim 10. Because the hindsight reconstruction of Appellant's claim is improper, Claim 10 is allowable over the proposed combination of references.

Appellant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant's claims, using Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellant respectfully submits that the proposed *Ward-Lewis-Lohmann-Cote-Carleton* combination is improper.

XI. Claim 18 is allowable under 35 U.S.C. § 103(a) over *Ward, Lewis, and Lohmann* in view of *Cote* and further in view of *Jones*?

Claim 18 depends from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann-Cote-Jones* combination. Claim 18 is allowable at least because the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine the cited references in the manner the Examiner proposes. Applicant's claims are allowable for at least these additional reasons.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, *Lewis*' teaching of filtering out and discarding irrelevant alarms would the performance and reliability of only relevant alarms being passed." (*Final Office Action*, page 22). It is not

clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant's claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing "filtering the alert condition to determine a notification path," as recited in Claim 1. It is not clear to Applicant how "filtering out and discarding irrelevant alarms" to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses "filtering an alert condition to determine a notification path associated with the alert condition," as argued by the Examiner, it is entirely unclear why the alleged motivation of "maximizing performance and reliability of the system" would lead one of ordinary skill in the art at the time of Applicant's invention to incorporate the teaching of "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of "maximizing performance and reliability of the system" would even be achieved by modifying the system of *Ward* to include "filtering an alert condition to determine a notification path associated with the alert condition," as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*.

Furthermore, Appellant respectfully notes that to reject Appellant's dependent claims, the Examiner pieces together bits and pieces of ten separate references. Even if the cited references disclose the elements alleged by the Examiner (which Appellant does not admit and has expressly disputed above), such a piecemeal rejection of Appellant's claim language fails to give credence to the particular combination of features recited in Appellant's claim. Appellant respectfully submits that a rejection of Claim 18 under the proposed combination, in the manner provided by the Examiner, can only result from piecing together disjointed portions of ten unrelated references to reconstruct Appellant's claims with the benefit of hindsight.

The Federal Circuit has made clear that is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed

invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, Appellant respectfully submits that the Examiner has used Appellant's claimed invention as an instruction manual to combining the teachings of *Ward*, *Lewis*, *Lohmann*, *Cote*, and *Jones* to conclude that the references disclose the elements of Claim 10. Because the hindsight reconstruction of Appellant's claim is improper, Claim 18 is allowable over the proposed combination of references.

Appellant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant's claims, using Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellant respectfully submits that the proposed *Ward-Lewis-Lohmann-Cote-Jones* combination is improper.

XII. Claims 23 and 24 are allowable under 35 U.S.C. § 103(a) over *Ward, Lewis, and Lohmann* in view of *Lawson*?

Claims 23 and 24 depend from independent Claim 1, which Appellant has shown above to be allowable over the proposed *Ward-Lewis-Lohmann-Lawson* combination. Claims 23 and 24 are allowable for at least because the Examiner has not provided an adequate reason, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine the cited references in the manner the Examiner proposes. Applicant's claims are allowable for at least these additional reasons.

With respect to the proposed combination of *Lewis* with *Ward* as relating to the independent claim, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of *Ward* and *Lewis* because *Lewis*'s teaching would allow *Ward*'s system to filter irrelevant alarms in order to maximize performance and reliability of the system (col. 7, lines 59-65).

(*Final Office Action*, page 4) Thus, it appears that the Examiner has merely proposed an alleged advantage of combining *Ward* with *Lewis* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes).

However, the alleged advantage of the system disclosed in *Lewis* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's disclosure or claims as a guide*) to modify the particular techniques disclosed in *Ward* with the cited disclosure in *Lewis*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear that is not the law.

Moreover, in the *Final Office Action*, the Examiner states, "Specifically, *Lewis*' teaching of filtering out and discarding irrelevant alarms would the performance and

reliability of only relevant alarms being passed.” (*Final Office Action*, page 22). It is not clear to Applicant how this statement even relates the manner in which the Examiner is attempting to combine these references or to Applicant’s claims. In the rejection, the Examiner appears to be using *Lewis* as allegedly disclosing “filtering the alert condition to determine a notification path,” as recited in Claim 1. It is not clear to Applicant how “filtering out and discarding irrelevant alarms” to purportedly achieve some improved performance and reliability has anything to do with the particular teachings the Examiner is trying to combine with *Ward*. More specifically, even assuming for the sake of argument only that *Lewis* discloses “filtering an alert condition to determine a notification path associated with the alert condition,” as argued by the Examiner, it is entirely unclear why the alleged motivation of “maximizing performance and reliability of the system” would lead one of ordinary skill in the art at the time of Applicant’s invention to incorporate the teaching of “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught in *Lewis*, into the system of *Ward*. In other words, it is not clear how the alleged advantage of “maximizing performance and reliability of the system” would even be achieved by modifying the system of *Ward* to include “filtering an alert condition to determine a notification path associated with the alert condition,” as purportedly taught by *Lewis*. Thus, Applicant maintains that it is entirely unclear and unexplained how the purported advantage even relates to the teachings that the Examiner is combining. Accordingly, the Examiner has not demonstrated an adequate reason to combine *Ward* and *Lewis*.

Furthermore, Appellant respectfully notes that to reject Appellant’s dependent claims, the Examiner pieces together bits and pieces of ten separate references. Even if the cited references disclose the elements alleged by the Examiner (which Appellant does not admit and has expressly disputed above), such a piecemeal rejection of Appellant’s claim language fails to give credence to the particular combination of features recited in Appellant’s claim. Appellant respectfully submits that a rejection of Claims 23 and 24 under the proposed combination, in the manner provided by the Examiner, can only result from piecing together disjointed portions of ten unrelated references to reconstruct Appellant’s claims with the benefit of hindsight.

The Federal Circuit has made clear that is improper for an Examiner to use hindsight having read the Applicant’s disclosure to arrive at an obviousness rejection. *In re Fine*, 837

F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, Appellant respectfully submits that the Examiner has used Appellant's claimed invention as an instruction manual to combining the teachings of *Ward*, *Lewis*, *Lohmann*, and *Lawson* to conclude that the references disclose the elements of Claims 23 and 24. Because the hindsight reconstruction of Appellant's claim is improper, Claims 23 and 24 are allowable over the proposed combinations of references.

Appellant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements for demonstrating a *prima facie* case of obviousness. Rather, the Examiner's attempt to combine *Lewis* with *Ward* appears to constitute the type of impermissible hindsight reconstruction of Appellant's claims, using Appellant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

For at least these reasons, Appellant respectfully submits that the proposed *Ward-Lewis-Lohmann-Lawson* combination is improper.


CONCLUSION

Appellant has demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

No fees are believed due; however, the Commissioner is authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellant


Jenni R. Moen
Reg. No. 52,038
(214) 415-4820

Dated: December 11, 2009

Correspondence Address:

at Customer No.

05073

APPENDIX A

Pending Claims

1. A method for generating an audio alert and processing an audio command, comprising:

detecting an alert condition identifying a problem with a system component, the alert condition being detected in response to an event notification associated with at least one of a plurality of heterogeneous application subsystems, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are distinct from the one or more information technology management operations performed by other application subsystems in the plurality of heterogeneous application subsystems;

filtering the alert condition to determine a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition, the object being stored in an object repository;

constructing an audio notification message based on at least one parameter associated with the alert condition;

outputting the audio notification message via the notification path;

receiving an audio command;

processing the audio command to derive command data;

constructing a command based on the command data; and

storing the command in the object repository.

3. The method of Claim 1, wherein constructing an audio notification message includes identifying a portion of the message that is likely to be difficult for a user to understand and replacing the identified portion with a more easily understood synonym.

4. The method of Claim 1, wherein detecting an alert condition includes detecting an alert condition within a plurality of subsystems of a network management application.

5. The method of Claim 1, further comprising defining at least one audio characteristic associated with the audio notification message.

6. The method of Claim 5, wherein the audio characteristic is a volume.

7. The method of Claim 5, wherein the audio characteristic is a balance.

8. The method of Claim 1, wherein the audio notification message is presented in accordance with a filter.

9. The method of Claim 1, wherein:
the notification path comprises a multi-tiered notification path, each tier of the multi-tiered notification path identifying one or more users assigned a level of responsibility with respect to the alert condition;

the determining the multi-tiered notification path includes determining the multi-tiered notification path, the determining the multi-tiered notification path including analyzing a parameter associated with the alert condition and selecting at least one tier of the notification path based on the parameter; and

the audio notification message is output via the at least one tier of the multi-tiered notification path.

10. The method of Claim 9, wherein determining the multi-tiered notification path includes analyzing an escalation list.

11. The method of Claim 1, wherein constructing the audio notification message includes:

determining a user associated with the audio notification message;

determining a language preference associated with the user; and

constructing the audio message based on the language preference.

13. A system for generating an audio alert and processing an audio command; the system comprising:

one or more memory units; and

one or more processing units operable to:

detect an alert condition identifying a problem with a system component, the alert condition being detected in response to an event notification associated with at least one of a plurality of heterogeneous application subsystems, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are distinct from the one or more information technology management operations performed by other application subsystems in the plurality of heterogeneous application subsystems;

filter the alert condition to determine a notification path associated with the alert condition, the notification path being determined based at least on a property of an object associated with the alert condition, the object being stored in an object repository;

construct an audio notification message based on at least one parameter associated with the alert condition;

output the audio notification message via the notification path;

receive an audio command;

process the audio command to derive command data;

construct a command based on the command data; and

store the command in the object repository.

15. A computer-readable storage medium encoded with processing instructions for generating an audio alert and processing an audio command, including:

computer readable instructions for detecting an alert condition identifying a problem with a system component, the alert condition being detected in response to an event notification associated with at least one of a plurality of heterogeneous application subsystems, each application subsystem in the plurality of heterogeneous application subsystems performing an associated one or more information technology management operations that are distinct from the one or more information technology management operations performed by other application subsystems in the plurality of heterogeneous application subsystems;

computer readable instructions for filtering the alert condition to determine a notification path associated with the alert condition, the notification path determined based at least on a property of an object associated with the alert condition, the object being stored in an object repository;

computer readable instructions for constructing an audio notification message based on at least one parameter associated with the alert condition;

computer readable instructions for outputting the audio notification message via the notification path;

computer readable instructions for receiving an audio command;

computer readable instructions for processing the audio command to derive command data;

computer readable instructions for constructing a command based on the command data; and

computer readable instructions for storing the command in the object repository.

17. The method of Claim 1, wherein:

the notification path comprises a multi-tiered notification path, each tier of the multi-tiered notification path identifying one or more users assigned a level of responsibility with respect to the alert condition; and

the method further comprises identifying the occurrence of a prior alert condition that was not responded to, the multi-tier notification path being determined based at least in part on the occurrence of the prior alert condition.

18. The method of Claim 1, wherein:
the notification path comprises a multi-tiered notification path, each tier of the multi-tiered notification path identifying one or more users assigned a level of responsibility with respect to the alert condition; and
the method further comprises assigning the level of responsibility to each of the one or more users based upon the severity of the alert condition.

19. The method of Claim 1, wherein:
the notification path comprises a multi-tiered notification path, each tier of the multi-tiered notification path identifying one or more users assigned a level of responsibility with respect to the alert condition; and
the method further comprises assigning the level of responsibility to each of the one or more users based upon a type of object associated with the alert condition.

20. The method of Claim 1, further comprising constructing an additional audio notification message if the audio notification message is not responded to within a designated time limit.

21. The method of Claim 1, further comprising constructing an additional audio notification message if the alert condition is not addressed within a designated time limit.

22. The method of Claim 1, wherein:
the notification path comprises a multi-tiered notification path, each tier of the multi-tiered notification path identifying one or more users assigned a level of responsibility with respect to the alert condition;
the audio notification message is output via the at least one tier of the multi-tiered notification path; and
the method further comprises filtering the audio notification message such that at least one user on the multi-tiered notification path does not receive the audio notification message.

23. The method of Claim 22, wherein filtering the audio notification message comprises filtering the audio notification message based on a property associated with an object associated with the alert condition.

24. The method of Claim 23, wherein the property is selected from the group consisting of a type of the object, a name of the object, a location of the object, the severity of the alert condition, the time of day, a level of risk, and an importance assigned to the object.

APPENDIX B

Evidence Appendix

Other than the references attached to this Appeal Brief as Appendices A and B, no evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, and no other evidence was entered by the Examiner and relied upon by Appellant in the Appeal.

APPENDIX C

Related Proceedings Appendix

As stated on Page 3 of this Appeal Brief, Appellant has identified two appeals that may be related to or that may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of the Appeal Briefs filed in 10/091,065 and 09/949,101 are attached.